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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/712,182

11/13/2003

Merrill Brooks Smith

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EXAMINER

TRAIL, ALLYSON NEEL

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/712,182	Applicant(s) SMITH, MERRILL BROOKS	
	Examiner Allyson N Trail	Art Unit 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-58 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/1/04, 1/20/04</u> | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description:

Paragraph 0022 includes a description management system 14, however 14 is not shown in figure 1. Additionally, paragraph 0026 discloses a terminal database/memory 26, however figure 2 shows the terminal database/memory as 25. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

2. Claims 33 and 50 are objected to because of the following informalities:

Claim 33 depends on claim 1, however claim 1 does not include a limitation of a "first transaction".

Additionally in claim 33, replace "the downloading" with --downloading--.

Re claim 50, line 2: replace "IVR" with --Interactive Voice Response--.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-4, 7-16, and 19-58 are rejected under 35 U.S.C. 102(e) as being anticipated by Risafi (6,473,500).

Risafi teaches the following in reference to claims 1-4, 7-10, 13-16, 19, 21, 22, 32, 34-38, 46-49, and 51 :

“A system for using a prepaid card permits a card user to purchase a card, issued by an issuer such as a bank, through an agent at a retail establishment via a terminal, select a PIN, have the card activated at the point of purchase, use the card to purchase goods and services, and reload the card for future use. The card can be used to purchase a wide range of goods and services including telephone services. The card can also be used to make cash withdrawals at an ATM or a point-of-sale terminal.” (Abstract).

“The card processing center stores the card number, PIN, and the balance in an account file. The card user is able to use the card at any terminal or other designated device connected through a network to the processing center to buy goods and services, to withdraw cash, and to add value to the card. The cardholder may also change the PIN using these devices. When conducting any of these transactions, the card processing center verifies the transaction's validity by checking the stored card number and PIN

Art Unit: 2876

against the card number read by the terminal and the PIN entered by the card user for that transaction.” (Col. 4, lines 5-16).

“The method for using the prepaid card includes purchasing a card issued by an issuer, perhaps through an agent at a retail establishment via an agent terminal, selecting a PIN, selecting the opening account balance, having the card activated at the point of purchase, and, over time, using the card to purchase goods and/or services.” (Col. 4, lines 17-21).

Risafi teaches the following in reference to claim 11:

The cards are displayed at the point of sale.

Risafi teaches the following in reference to claim 12:

The stored-value card may be used for any application, therefore before value is added to the card, the card is a “dummy card”.

Risafi teaches the following in reference to claim 20:

“Telephone services may also be paid for on a prepaid basis. Such prepaid cards, issued by TELCOs and other companies who buy and resell time from TELCOs, are widely available at many retail establishments.” (Col. 2, lines 58-61).

Risafi teaches the following in reference to claims 23 and 31:

“21) The invention is used in other areas. The invention is also directed to the use of prepaid cards to fulfill payroll obligations, facilitate gift-giving, promote the purchase of specific products or services, transfer money between at least two cardholders, purchase corporate relocation expenses, and manage incentive programs to reward employees, dealers, and others.” (Col. 5, lines 11-17).

Additionally, figure 10a shows a flowchart illustrating a process for using a prepaid card as a gift in accordance with an embodiment of the invention.

Risafi teaches the following in reference to claims 24-30, 33, and 40-45:

“Another use for the card is to facilitate spending for corporate relocation expenses for either new or transferred employees. In this scenario, an employer loads value into a card account and gives the card to the employee who selects a PIN. The employee then uses the card for relocation expenses such as meals, gas, etc. If the value is depleted, the employer is able to load more value into the card account. The employer is also able to select in which merchant categories the employee will be able to use the card to purchase goods or services.” (Col. 9, lines 58-67). Although each specific use of the card disclosed by the current application is not disclosed, Risafi teaches that the card may be used in any application and therefore teaches the card’s use in claims 24-30, 33, and 40-45.

Risafi teaches the following in reference to claim 39:

“When the card's value is depleted, the card is typically discarded.” (Col. 2, lines 24-25).

Risafi teaches the following in reference to claim 50:

“The user selects a PIN of his or her choice upon inserting the purchased card into an terminal or by accessing another designated device, such as a interactive voice response unit ("IVRU").” (Col. 3, line 65 – Col. 4, line 1).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 5, 6, 17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Risafi (6,473,500) in view of Poore et al (6,202,933).

Risafi's teachings are discussed above. Risafi fails to teach the stored-value card including a barcode, wherein the barcode is used as a product identifier.

Poore et al teaches the following in reference to claims 5, 6, 17, and 18:

Figure 1 shows a stored value card 12. The card is shown to include an encoded magnetic stripe 16 positioned thereon, a printed or embossed account number 17 and an encoded barcode region 18 as well. The magnetic stripe 16 is encoded with account number information. The barcode 18, as will be set forth in greater detail hereafter, includes a four digit plain text batch number field containing the batch number in plain text form and a 16 digit encrypted information which may be decrypted to determine whether the account information either in the magnetic stripe 16 or embossed or printed 17 on the card is legitimate or forged. (Col. 3, lines 1-15).

In view of Poore et al's teachings, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to include on the keycard taught by Risafi, the barcode as taught by Poore et al. Risafi includes the teaching of a customer PIN in order to prevent fraudulent use of the keycard. One would be motivated to use in addition to the PIN, a barcode, whose purpose is to safeguard against card forgery.

Art Unit: 2876

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Resnick et al (2001/0001321), Berardi et al (2004/0260646), Bishop et al (2004/0232225), Breck et al (2004/0210449), Blair et al (2004/02110476), Stoutenburg et al (2003/0222135), Noriega et al (2003/0218062), and Lesley (2001/0000808).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Allyson N. Trail* whose telephone number is (571) 272-2406. The examiner can normally be reached between the hours of 7:30AM to 4:00PM Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (571) 272-2398. The fax phone number for this Group is (703) 872-9306.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [allyson.trail@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published

Art Unit: 2876

in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG

89.

Allyson N. Trail
Patent Examiner
Art Unit 2876
January 10, 2005

A handwritten signature in black ink, appearing to read 'Karl D. Frech', with a stylized, flowing script.

KARL D. FRECH
PRIMARY EXAMINER